

## BRIEF IN SUPPORT OF PETITION

### Opinions Below.

The opinion (not reported) of the District Court of the United States for the District of Columbia, on the question here involved, appears at page 5 of the record; and the opinion of the United States Court of Appeals for the District of Columbia (not reported) appears at page 14 of the record.

### Jurisdiction.

The decree below was entered on January 15, 1945 (R. p. 15). The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925; U. S. C. Title 28, Section 347 (a).

### Statement of the Case.

The principal facts pertinent to the single question are sufficiently stated in the Petition, *ante*, pages 2-3.

### Specification of Errors.

(1) The United States Court of Appeals for the District of Columbia erred in finding and holding that a geographical name used in an arbitrary and fanciful sense as a mark indicating the producer or originator of the goods, and having no significance as to any place where the goods are or could be produced, is "merely a geographical name or term" within the meaning of Section 5 of the Trade-mark registration Act of February 20, 1905 and that it therefore is not registerable.

(2) The said Court erred in affirming and in not reversing the decree of the District Court holding the mark "ANTARCTICA" to be "merely a geographical name or term" within the meaning of the Trade-mark Act of February 20, 1905 and dismissing the complaint.

### Summary of Argument.

The points of argument follow the reasons relied upon for the allowance of the writ and are conveniently summarized in the petition under "Reasons for Granting the Writ", *ante*, pp. 4-8.

### Statute Involved.

The statute involved is Section 5 of the Trade-mark Act of February 20, 1905, U. S. C., title 15, sec. 85, the relevant part of which is as follows:

"That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark \* \* \*

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, \* \* \*: *Provided, That no mark* which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or *merely a geographical name or term*, shall be registered under the terms of this Act: \* \* \*." (Italics added)

**ARGUMENT.****POINT I.**

The decision of the Court below is based upon an interpretation of the words "merely a geographical name or term" of Section 5 of the Trade-mark Act of February 20, 1905 which apparently is in conflict with decisions of this Court bearing thereon.

This Court has declared, in *American Steel Foundries v. Robertson*, 269 U. S. 371, 381, that it must be assumed that, when the registration statute of February 20, 1905 was enacted, Congress must have had in mind the principles of the substantive law of trade-marks; that the provisions of the Act are to be construed in the light of and in harmony with the established principles of that substantive law; and that in passing the Act, it was the intention of Congress to permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a valid trade-mark.

As this Court has repeatedly pointed out, the office of a trade-mark is to distinguish, to set apart, the goods of a particular trader from those of other traders. If a mark, whatever be its character, performs that office *at the time of its adoption*, it is a true trade-mark, valid at common law. There is no doubt of the rule. As to what may be a trade-mark, this Court has said, in *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665,

"It (a trade-mark) may consist in *any* symbol or in *any* form of words, but as *its office is to point out distinctively the origin or ownership of the articles to which it is affixed*, it follows that no sign or form of words can be appropriated as a valid trade-mark which, from the nature of the fact conveyed by its primary meaning, others may employ with equal truth and with equal right for the same purpose.

"And the general rule is thoroughly established that words that do not in and of themselves indicate anything in the nature of origin, manufacture, or owner-

ship, but are *merely descriptive of the place where an article is manufactured or produced*, cannot be monopolized as a trade-mark." (Italics added).

This Court, in *Delaware & Hudson Canal Co. v. Clark*, 13 Wall. 311, has likewise stated that:

"The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, *to give notice who was the producer*. This may, in many cases, be done by a name, a mark, or a device well known, but not previously applied to the same article. . . .

"Hence the trade-mark must either by itself, or by association, *point distinctively to the origin or ownership of the article to which it is applied*. The reason of this is that unless it does, neither can he who first adopted it be injured by any appropriation or limitation of it by others, nor can the public be deceived. The first appropriator of a name or device *pointing to his ownership*, or which by being associated with articles of trade, has acquired an understood reference to the originator, or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is in effect representing falsely that the productions of the latter are those of the former. . . . The trade-mark must, therefore, be distinctive in its original signification, pointing to the origin of the article, or it must have become such by association. And there are two rules that are not to be overlooked. No one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark and the exclusive use of it be entitled to legal protection. As we have said in the well-considered case of *Amoskeag Mfg. Co. v. Spear*, *supra* 'the owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms,

or symbols that were *appropriated as designating the true origin or ownership of the article or fabric to which they are affixed*; but he has no right to the exclusive use of any words, letters, figures or symbols which have *no relation to the origin or ownership of the goods*, but are only meant to indicate their names or quality. He has no right to appropriate a sign or symbol *which from the nature of the fact it is used to signify, others may employ with equal truth* and, therefore, have an equal right to employ for the same purpose.' . . .

"And it is obvious that *the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies.*" (Italics added)

These frequently approved decisions of this Court are clear and satisfactory expositions of the philosophy of the substantive law of trade-marks. From them it is evident that the gist of a trade-mark is its function of signifying to the public mind that the goods to which the mark is affixed are the product of a particular manufacturer or originator. From them it is evident also that, *at common law, a geographical name is not precluded from being a trade-mark simply because it is geographical, but, as is true of all names or marks generally, it fails of being a trade-mark if it does not signify to the public mind the manufacturer or originator of the goods to which it is affixed.* That this is the correct rule of the common law is unquestionable. Whether a term associated with the particular goods to which it is affixed as a "mark" is, in the sense of the common law, merely geographical or not must depend in the last analysis upon whether the public might suppose that the term signified a *place* where the goods originated,

and this because the only reason Congress had for prohibiting the registration of geographical names was that, as pointed out by this Court in the cases above quoted from, it would interfere with the rights of others who had an equal right to use the term to indicate that their goods came from that place.

Where a geographical name or term is used in an arbitrary and fanciful sense *not signifying* to purchasers the *place* from which the goods so marked came, *but indicating instead the particular manufacturer or producer of the goods*, it is a legitimate trade-mark, for it is then not "merely geographical", *not* "merely descriptive . . . of the *place* where it is manufactured or produced", *not* "merely descriptive of the *place* where an article is manufactured or produced", and *not* "merely a geographical name" within the intent and meaning of those phrases as they are used in the *Brown Chemical Co.*, *Columbia Mill Co.* and *Elgin* cases, *supra*. A name or term may have geographical significance when considered simply as a mere word alone, but if, *as a "mark" affixed to an article of trade, it signifies to the mind of the public the particular manufacturer or originator of the article*, it is, properly speaking, *not* "merely geographical", nor, indeed, "geographical" at all in the sense of the substantive law of trade-marks.

## POINT II.

"Antarctica" is used in an arbitrary and fanciful sense as a trade-mark, and no one could have need to employ it in the sense of indicating or describing his goods as coming from that region.

"ANTARCTICA" is a geographical name. But as a "mark" affixed to respondent's goods (soft drinks, extracts, syrups) it is purely fanciful. It was arbitrarily selected to indicate to the public the manufacturer or producer of the goods. The public could not reasonably understand it to have any other signification in relation to the goods to which it is affixed.

It could not reasonably be regarded by purchasers as signifying the *place* of manufacture or *place* of origin of the goods or their ingredients, for it is common knowledge that the region called "Antaretica" is totally uninhabited and is a land of perpetual snow and ice incapable of supporting human life (National Geographic Magazine, August 1920, page 127 et seq.). It is manifestly impossible for any one to engage in business in "Antaretica" or for commerce to exist between it and any part of the world. No one could have occasion to employ "Antaretia" in his business in the sense of indicating or describing his goods as coming from that region. Petitioner's arbitrary and fanciful use of "Antaretica" as a trade-mark therefore does not interfere with or embarrass any public or private right.

No person, seeing "ANTARCTICA" affixed to the goods, would ever reasonably entertain a belief that it signified the *locality* where the goods or their ingredients were manufactured or originated, any more than he would believe that the word "Brobdingnag," the land of the giants of Swifts' Gulliver's Travels, if affixed to an article of trade, signified that the article was produced there, or that the name "North Pole" affixed to a lead pencil was intended to indicate the *place* of production of the pencil. Recognizing the practical and commercial impossibility of manufacturing any goods in "Antaretica", it would be at once apparent to the purchasing public that the mark "ANTARCTICA" was used on the goods in purely arbitrary and fanciful sense and, to the exclusion of all else, was affixed to the goods for the purpose of identifying them as the product of a particular manufacturer or producer. No other deduction would be reasonable or sensible. Any other deduction would be absurd and against common sense.

In the sense of the rule of the substantive law of trade-marks respecting the appropriation of geographical names used in an arbitrary and fanciful sense as "marks" for goods, "ANTARCTICA" is not "merely a geographical name", but is a valid trade-mark at common law.

The rule that geographical names or terms which are arbitrarily and fancifully used to identify the producer of the goods are valid trade-marks at common law is expressed in the "Restatement of Law—Torts", Section 720, as follows:

"A geographical name cannot be a trade-mark for goods unless (a) the use of the name in connection with such goods is not likely to be understood by purchasers as representing that the goods or their constituent materials were produced or processed in the place designated by the name or that they are of the same distinctive kind or quality as the goods produced, processed or used in that place, \* \* \*."

### POINT III.

The words "merely a geographical name or term" of Section 5 of the Trade-mark registration Act of February 20, 1905 are susceptible of, and have been given, more than one judicial interpretation. The proper interpretation is that which is in harmony with the substantive law of trade-marks and effectuates the intention of Congress to permit registration of all trade-marks valid at common law.

There has been a diversity of judicial opinion of Courts and various Commissioners of Patents (*ante*, pp. 7-9) as to the proper interpretation of the provision of Section 5 of the Trade-mark Act of February 20, 1905 that "no mark . . . merely a geographical name or term, shall be registered under the terms of this Act."

It has been held in some decisions (*ante*, pp. 8-9) that by the use of the words "merely a geographical name or term" the Act precludes registration of *all* geographical names or terms whatsoever, irrespective of their validity or invalidity as trade-marks at common law. Other decisions (*ante*, pp. 7-8) have held that the provision of the Act denying registration to marks which are "merely a geographical name or term" is *not* to be understood as



precluding registration of *all* geographical names or terms, but is properly to be interpreted as permitting registration of those geographical names or terms which are used in an arbitrary and fanciful sense and which, as "marks" affixed to the goods, are not "*merely*" geographical since they have no geographical signification in the public mind as to a place where the goods are or could be manufactured or produced.

The first of these two interpretations—the one currently being applied by the Commissioner of Patents, the Court of Appeals below and the Court of Customs and Patent Appeals—is not in harmony with the substantive law of trade-marks and is contrary to the intention of Congress in passing this trade-mark registration statute. It probably grows out of the failure by courts and Commissioners of Patents to correctly distinguish and give effect to the difference between the signification of a word to the public when, on the one hand, it is used as a "*mark*" affixed to goods, and when, on the other hand, it is used *simply as a word* of ordinary speech. This distinction is fundamentally inherent in the substantive law of trade-marks, as appears from the decisions of this Court in the *Columbia Mill case* and in the *Elgin case, supra* (*ante*, pp. 5-6). It is implicit in the statute itself, dealing, as it does, with the registration of trade-marks. Moreover, Section 5 of the Act, which is the section here involved, expressly recites that it concerns the registration of *marks* "by which the goods of the owner of the mark may be distinguished from other goods of the same class," i. e., trade-marks.

The word "mark" occurring in the portion of Section 5 of the Act reading:

"*Provided*, That no mark . . . merely a geographical name or term, shall be registered under the terms of this Act",

should obviously be understood here in the same sense in which it is used in the substantive law of trade-marks and as it is used elsewhere in the Act, namely, a "*mark*" af-

*fixed to the goods.* And the *meaning* of a "mark", in the sense of the substantive law of trade-marks, is its meaning to the public when *associated with the goods*. Its meaning to the public when it is *not* affixed to the goods, but as it is used in common speech, is *not* its meaning as a "mark" in the sense of the law of trade-marks. For example, the word "Anchor" affixed as a "mark" to a tin of tobacco would obviously signify to the public nothing more than that the tobacco within the tin so marked was the product of a particular manufacturer or processor. It has an entirely different meaning when it is not used as a "mark" affixed to goods. The same is true as to the meaning in the sense of the substantive law of trade-marks of any "mark" *affixed to the goods*. If, therefore, a geographical name or term when seen as a "mark" *affixed to goods* primarily means to the public a particular producer or manufacturer of the goods, that "mark" is not "merely" a geographical name or term in the sense of the law of trade-marks, since, as *affixed to the goods*, its signification to the public is *not* that it points to a *place* where the goods are or may be produced.

The diversity of judicial opinion by Courts and Commissioners of Patents as to the proper interpretation of the words "no mark . . . merely a geographical name or term" apparently arises out of the failure, in some instances, to recognize that, in the light of the substantive law of trade-marks as set forth in decisions of this Court, a "mark" (trade-mark) is not "*merely* a geographical name or term", if its significance to the public as a "mark" is something other than geographical.

### CONCLUSION.

The granting of a writ of certiorari in this case is peculiarly appropriate. The question is one never decided by this Court and upon which considerable diversity of judicial opinion exists. The uncertainty as to the proper interpretation of the proviso of Section 5 of the Trade-

mark Act of February 20, 1905 that "no mark . . . merely a geographical name or term shall be registered under the terms of this Act", will be removed by a decision of this Court in this case, and the Commissioner of Patents, the United States Court of Customs and Patent Appeals and the United States Court of Appeals for the District of Columbia will thenceforth be enabled to apply this portion of Section 5 to the statute correctly and with uniformity.

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